



Response under 37 C.F.R. 1.116
- Expedited Examining Procedure -
Examining Group 3624

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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of:
Richard L. Alfvin, et al

ELECTRONIC IMAGING CAPTURE
AND BILLING DISTRIBUTION
SYSTEM

Serial No. US 09/607,140

Filed 29 June 2000

Group Art Unit: 3624

Examiner: Narayanswamy
Subramanian

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RESPONSE UNDER 37 CFR 1.116

In response to the Official Action dated April 22, 2003, applicant respectfully requests reconsideration in view of the following remarks.

The Examiner in the Official Action has finally rejected Claims 1 - 16 for reasons set forth of record. In particular, the Examiner has maintained the rejection of Claims 1, 2 and 8 - 14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Reeley, et al. (U.S. Patent 5,893,037) in view of Kolling et al. (U.S. Patent 6,385,585 B1) and Claims 3 - 7 as being unpatentable over Reeley et al in view of Kolling et al. and Enomoto et al.

The Examiner also maintained the rejections of Claim 4 - 6 under 35 U.S.C. 103(a) as being unpatentable over Reeley, et al. in view of Kolling et al. and Enomoto et al. and further in view of Loeb et al. Finally the Examiner further maintained the rejection of Claims 15 and 16 under 35 U.S.C. 103(a) as being unpatentable over Kolling et al. in view of Loeb et al. for the reasons of record.

With regard to independent Claims 1 and 9, the Examiner has provided responses to applicants' previous arguments. Examiner acknowledges that Reelee et al. does not provide a periodic statement. Accordingly, Reelee et al. could not teach or suggest providing a visual representation of captured images taken during a predetermined time period along with a periodic statement. The Examiner relies on Kolling et al. for disclosing and providing a periodic statement. In rejecting Claims under 35 U.S.C. 103(a), it is incumbent upon the Examiner to establish a factual basis to support the legal conclusion of obviousness. See *in Re Fine*, 837 10d 1071, 1073, 5 USPQ 2d 1596. In so doing, the Examiner is expected to make the factual determinations as set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 17, 148 48 USPQ 457 (1966) and to provide a reason why one having ordinary skill in the pertinent art would have been led to modify the prior art or to combine prior art references to rise at the claimed invention. Such reason must stem from some teaching, suggestion or implication in the prior art as a whole or knowledge generally available to one having ordinary skill in the art.

Applicant respectfully submits that there is no motivation or suggestion in combining the references suggested by the Examiner. It is almost always possible to piece meal the prior art to come up with applicants' invention. However, there must be a clear teaching and/or suggestion in the prior art to make the combination suggested. In this regard, the Reelee et al. reference is simply directed to a combination of a digital camera with a cellular communication transmission device. There is no teaching or suggestion of storing of the digital captured images by the communication provider. Reelee et al. is simply directed to transmitting or receiving digital images over the communication network (see column 5, lines 25-49). Thus, it can be seen that this reference is merely the transmission of images directly from the combination cellular phone image captured device to another location.


With respect to the Kolling et al. invention, this reference is simply directed to provide electronic statements for a credit card company. There is no teaching or suggestion of storing digital images captured. This is directed to a totally different field than that of the Kolling et al. reference. As set forth in the 'Field of the Invention' in Kolling et al., Kolling is directed to an electronic

statement presentation system, in particular, a system that allows the ability to direct a statement or invoice electronically to a consumer. Knolling et al. is not directed to capturing or storing of digital images on behalf of customers. It is directed to electronic billing of customers. There is no teaching or suggestion in either of the cited references to combine one with the other, nor would there be any motivation to do so. The motivation as presented by the Examiner is based on hindsight and modified by any teaching or suggestion in the references. There is no logic basis why one in the telecommunication business would look to an electronic billing statement as suggested. Further, it is respectfully submitted that neither of the cited references could not teach the invention as taught as claimed. Neither teach sending a bill for communication services that includes visual representation of images for ordering of goods and/or services with respect to these images.

With respect to the Loeb et al. reference, this reference is directed to a system providing an open-ended subscription to commodity items normally available on a term basis which includes a central agent that serves as the front-end for commodity suppliers. Loeb et al. is not directed to storing images on behalf of our customers nor is it directed to a billing invoice for a teller communication in imaging services for a predetermined time period. Nor is there any teaching or suggestion in providing an order form for obtaining photographic goods and/or services. The Kolling et al. and Loeb et al. references provide a statement as set forth in Claim 15 as taught as claimed. Accordingly, it could not render obvious the present invention as missing an important element of the claimed invention.

In summary, it is respectfully submitted that the application is in condition for allowance and such action is respectfully requested.

Respectfully submitted,



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